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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/045,431

01/11/2002

Kuan-Yu Lee

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7590

09/23/2004

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EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/045,431

Applicant(s)

LEE, KUAN-YU

Examiner

Jerome Grant II

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### Detailed Action

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawther..

With respect to claim 1, Lawther teaches an automatic photograph producer 2 comprising: a platform 64; a top panel 9 inside region of the top portion of scanner 56); a storage area (cassette holder for holding film 10) for holding a plurality of different frames of a film; an automatic feeder (col. 4, lines 18-24) for transporting the transparencies stored inside the storage area to the platform ; a penetrating light source 62 for the purpose claimed; a printer 74 for printing the scanned result.

With respect to claim 2, Lawther teaches scanning of transparent documents 10.

With respect to claim 3, Lawther teaches the light panel is light element which is inherent in 62.

With respect to claim 4, the mask is taught by element 64.

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With respect to claim 8, Lawther teaches a method for producing photographs (from film 10) using an automatic photographic producer including the steps of : pushing an execution button (inherent, which causes the system to be turned on and/or the scanning operation to be executed); scanning a transparency (10) via scanner 56 with light emitted from source 62; and printing out(via printer 74) the image obtained by scanning the transparency on printing paper.

With respect to claim 9, Lawther teaches feeding a transparency (motor according to col. 4, lines 18-24) and an image on paper (hard copy) according to element 74. With regard to the detection of the print size, see col. 1, lines 34-44.

With respect to claim 11, Lawther teaches a computer 60 which contains means for selecting parameters, see col. 4, and step 1.

With respect to claim 12, Lawther teaches a 1.5X, 2X and 3X telephoto indications 34, 42 and 38 indicating the resolution or image quality of the document. The size of the document is disclosed at col. 1 lines 34-44

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawther.

With respect to claim 5, Lawther teaches all of the subject matter upon which the claim depends except for the storage area is above the top panel. Lawther shows where the storage area is below the top panel. However, based on the teaching of

Lawther, it would have been obvious to one of ordinary skill in the art to rotate the assembly by 180 degrees in order to obtain the result of the storage area above the panel for the purpose of projecting light through the film so that the image is projected onto a scanning surface.

With respect to claim 6, Lawther teaches all of the subject matter upon which the claim depends except that it is not clear if the reference teaches the feeder mounts on the top panel. However, the feeder elements are not shown according to col. 4, lines 18-24. But, it would have been obvious to one of ordinary skill in the art to mount a motor for feeding the film on the top portion of the scanner 56 as opposed to the bottom (which the reference teaches) for advancing the film to a scan region between marks 64, for the purpose of conveying a transparent means into a scanning area to read the film or transparency members.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawther in view of Haas.

Lawther teaches of the claimed subject matter upon which the claim depends, except for a position detection means as claimed.

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Haas teaches a transparency orientation means for adjusting the orientation system 130 to properly position the transparency before the scanner.

Since, Lawther and Haas are both directed toward image scanning systems for reading transparencies, the purpose of detecting the position of a transparency would have been recognized by Lawther as set forth by Haas.

It would have been obvious to one of ordinary skill in the art to modify the scanning means 56 to include the position detection means 130 of Haas to adjust for transparencies to that they are properly registered over the scanning area at the time of scanning for the purpose of improving the scanning means.

4.

#### **Claims Objected**

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

JEROME GRANT II  
PRIMARY EXAMINER